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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIVA SUBRAMANIAN and TAL I. LAVIAN
Appeal 2008-001043
Application 09/736,678
Technology Center 2400

Decided: September 24, 2009

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
and DEBRA K. STEPHENS and JAMES R. HUGHES, *Administrative
Patent Judges*.

MACDONALD, *Vice Chief Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 1-50. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We affirm.

STATEMENT OF THE CASE

According to Appellants, the invention relates to distributing application level processing among one or more routing devices in a network, during high speed routing.¹

Exemplary Claim

1. A method for distributing processing among routing nodes capable of providing application level support during routing, the method comprising:

 configuring the routing nodes to include a control plane, a compute plane and a forward plane;

 identifying processing resources required to provide application level support during routing for select traffic;

 selecting at least one routing node capable of providing the processing resources required to provide the application level support for the select traffic in the compute plane of the at least one routing node; and

 routing the select traffic through the at least one routing node capable of providing the processing resources required to provide the application level support,

 wherein the at least one routing node provides the application level support for the select traffic while routing the select traffic.

¹ Spec. 1:16-17.

Prior Art

The Examiner relies on the following prior art references to show unpatentability:

Nessett	6,421,734 B1	Jul. 16, 2002
Denecheau	6,611,874 B1	Aug. 26, 2003
Chiu	6,701,363 B1	Mar. 2, 2004

Examiner's Rejections

1. The Examiner rejected claims 1-50 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent 6,970,943.
2. The Examiner rejected claims 1-47 and 50 under 35 U.S.C. §103(a) as unpatentable over Denecheau, Applicant's Admitted Prior Art (AAPA) and Nessett.
3. The Examiner rejected claims 48 and 49 under 35 U.S.C. §103(a) as unpatentable over AAPA, Nessett and Chiu.

OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

We find that Appellants have not raised any arguments alleging error in the Examiner's finding of double patenting over U.S. Patent 6,970,943. Arguments not made by Appellants in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008) ("Any arguments or authorities not included in the brief or a reply brief ... will be refused consideration by the Board, unless good cause is shown."). *See also Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir 2008) ("When the appellant fails to contest a ground of rejection to the Board, section 1.192(c)(7) [(now section 41.37(c)(1)(vii))] imposes no burden on the Board to consider the merits of that ground of rejection. . . .

[T]he Board may treat any argument with respect to that ground of rejection as waived.”).

Thus, on the record before us, Appellants have waived all such arguments, and fail to rebut the Examiner’s prima facie case of obviousness-type double patenting. Accordingly, we sustain the Examiner’s obviousness-type double patenting rejection of claims 1-50.

THE REJECTION OVER DENECHAU, AAPA, AND NESSETT

Claims 1-47 and 50

Examiner's Findings and Conclusions

The Examiner found that "Denecheau and AAPA fail to teach the limitation further including the use of routing nodes including a compute plane." (Ans. 5). However, the Examiner found that "Nessett teaches packets that are transmitted through an intermediate device which applies compression and/or encryption" (*id.*). The Examiner then found that (1) "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify Denecheau and AAPA in view of Nessett to include a compute plane, with functions such as compression and encryption, as part of a routing node," and (2) "[o]ne would be motivated to do so because compressed data can help preserve bandwidth." (*Id.* at 5-6).

Further, the Examiner found (1) "[t]he specification defines a compute plane on page 13, lines 21- 30, [and] specifically that 'the compute plane is capable of implementing virtually any type of application, ranging from carrying out mathematical operations on payloads to implementing compression and encryption algorithms;'" (2) "Nessett teaches, on column 2, lines 14-38, packets that are transmitted through an intermediate device,

which applies compression and/or encryption;" and (3) "Nessett teaches functions of the compute plane as defined by the specification" and "therefore it is has the compute plane used in the claimed limitations." (Ans. 17).

Appellants' Arguments and Contentions

Appellants argue "[t]here is no teaching that the decompression and compression resources 112, 113 of Nessett are within a compute plane as recited in the claims" (App. Br. 14). Further, Appellants argue "[t]he Patent Office asserts that it would be obvious to include a compute plane with functions such as compression and decompression as part of the routing node ... per the claims, but there is no explanation for why the decompression and compression resources 112, 113 of Nessett would be moved to a compute plane per the claims." (App. Br. 14).

ISSUE

The issue before us is whether Appellants demonstrate error in the Examiners finding that the prior art teaches or suggests a compute plane.

PRINCIPLES OF LAW

During patent examination, claims are given their broadest reasonable interpretation in light of the specification as it would be interpreted by skilled artisans. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (citations omitted). Also, "although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. ... [C]laims may embrace different subject matter than is illustrated in the specific

embodiments in the specification.” *Id.* at 1323 (citations and internal quotation marks omitted).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Discussing the question of obviousness of claimed subject matter involving a combination of known elements, *KSR Int’l v. Teleflex, Inc.*, 550 U.S. 398 (2007), explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida [v. Ag Pro, Inc.]*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock[, Inc. v. Pavement Salvage Co.]*, 396 U.S. 57 (1969)] are illustrative - a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Id. at 417. If the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that “there was an apparent reason to combine the known elements in the fashion claimed.” *Id.* at 418. Such a showing requires:

“some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

Id. (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

If the Examiner’s burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Claim 1 recites “configuring the routing nodes to include a control plane, a compute plane and a forward plane” (App. Br. 19, Claims App’x).

While the Examiner found that “Nessett teaches packets that are transmitted through an intermediate device which applies compression and/or encryption” (*see* Ans. 5), we find that the Examiner fails to adequately explain why the intermediate device of Nessett is equivalent to a compute plane. Therefore, for the reasons argued by Appellants, we find error in the Examiner’s conclusion of obviousness regarding exemplary claim 1, and reverse the Examiner’s rejection of claim 1.

Appellants argue claims 1-47 and 50 as a group. (App. Br. 14-16). Therefore, for the foregoing reasons with regard to exemplary claim 1, Appellants have persuaded us of error in the Examiner’s conclusion of

obviousness with respect to claims 2-47 and 50. Accordingly, we also reverse the Examiner's rejection of claims 2-47 and 50.

THE REJECTION OVER DENECHAU, AAPA, NESSETT AND CHIU

Claims 48 and 49

Appellants argue the rejection of claims 48 and 49 for the same reasons argued with respect to claims 1-47 and 50. (App. Br. 17). Further, Appellants argue (1) "the Patent Office has offered no actual evidence to support the stated motivation", and (2) "the combination is improper" (App. Br. 17).

Claims 48 and 49 depend from independent claim 1 (*see* App. Br. 30, Claims App'x). Thus, for the foregoing reasons found with regard to exemplary claim 1, Appellants have persuaded us of error in the Examiner's conclusion of obviousness with respect to claims 48 and 49. Accordingly, we reverse the Examiner's rejection of claims 48 and 49.

DECISION

We affirm the Examiner's double patenting rejection of claims 1-50 and reverse the Examiner's 35 U.S.C. §103(a) rejections with respect to claims 1-50.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

AFFIRMED

nhl

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Application 09/736,678

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